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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,693	01/07/2002	Margaret Ann Kato	659/921	7442

7590

08/18/2005

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EXAMINER
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SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/041,693

Applicant(s)

KATO ET AL.

Examiner

Bruce E. Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40 and 43-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40 and 43-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/8/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 6/8/05 have been fully considered but they are not persuasive.

#### Claim 44

Regarding claim 44, applicant argues that Repke et al teaches the elastic member is intermittently secured in the elongate passage and is not "substantially freely movable with said elongate passage". As noted in the grounds of rejection, it is the Examiner's position that intermittently joined is substantially freely movable, especially when compared with being continuously joined. The term "substantially" is a broad term; see MPEP 2173.05(b)d.

Regarding the rejection in view of Kenji (Japan 4-35498), applicant states Kenji is silent regarding that the elastics are secured to the elongate passage. The Examiner disagrees, Kenji does not join the elastic inside the passage; that is why there is no teaching of a joining means.

#### Claim 51

Repke et al teaches an outer cover having two layers: "On the other hand, the outer ply can be an inherently hydrophilic web which is treated so as to be moisture-repellent or moisture-impervious, for example, by spraying the outer layer with a hydrophobic agent." See column 9, lines 40 et seq.

Additionally, if the absorbent is enveloped with a layer which can be interpreted as the liquid-permeable layer.

Claims 46-50

The same materials inherently have the same characteristics and when used in the same way inherently function the same, or as claimed. Because the Patent & Trademark Office does not have the testing facilities to provide factual evidence needed to establish that the claimed invention or subject matter is unobvious, the examiner properly shifts the burden to Applicants to show that unobvious differences exist, *Ex parte Phillips*, 28 USPQ 1302 (Bd Pat App & Inter, 4/27/93).

Claims 40, 43, 45, and 52, No Suggestion to Modify Repke or Kenji

Applicant teaches both configurations and provides **no advantage** or solves no stated problem; see at least 37:5-8 of 6,336,921 (applicant's specification). One of ordinary skill in the art would have expected applicant's invention to perform equally well with either configuration because both form a passage for the elastic. The use of the claimed configuration is deemed to be a design consideration which fails to patentably distinguish over the prior art.

Regarding the Kenji rejection, the back sheet 24 is folded inward to form the channel for elastic member 23, if the back sheet was folded the opposite direction there is no advantage as stated in the grounds of rejection.

Claims 46-50

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Weil et al teaches that elastic materials in an elastic waist system undergoing sustained stress/strain (extension/contraction) have diminishing forces with time (i.e. elastic creep). Therefore, it is desired to make sure this reduction in wearing forces over time doesn't fall below a minimum for wearing stability. **The elastic creep (decay) should be kept to a minimum.** See column 34, lines 51 et seq. (Weil et al further teaches the waist elastic system should not have insufficient contractive forces that result in the diaper slipping down after being worn and loaded. In contrast, excessive contractive forces may reduce the comfort for the wearer producing pressure markings on the wearer's skin. See column 34, lines 20 et al.) It would have been obvious to one having ordinary skill in the art to have utilized the concept of keeping the elastic decay to a **minimum** and/or materials as taught by Weil et al with the closed-loop waist elastic system of Repke et al to maintain the functional integrity of the waist system over repeated cycling, in doing so, fulfilling the specific claimed decay values/range.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 44 and 46-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Repke et al (4,205,679).

Referring to all figures and embodiments, specifically figures 11-13, Repke et al teaches a disposable absorbent pant comprising:

a multi-layer chassis including an outer cover 212, a liner (see column 9, lines 11-16), and an absorbent structure 264 disposed between said outer cover and said liner, said outer cover having a first surface facing said liner and a second surface opposite said first surface, said chassis formed as a pant and including a waist opening and a pair of leg openings, one layer of said multi-layer structure including an extension

portion extending beyond an edge of another layer of said multi-layer structure and peripherally surrounding said waist opening; and

a closed-loop waist elastic system including an elongate sleeve member 242, 244 defining an elongate passage therein, said waist elastic system being generally peripherally disposed about said waist opening, and at least one elongate elastic member disposed within said elongate passage, said elongate passage formed by folding said extension portion upon itself and joining an end portion of said extension portion to a surface of said extension portion; see at least figure 11.

Regarding claim 44, "elastic member is substantially freely movable", see column 15 lines 22 et al teaching the elastic members can be intermittently attached.

Regarding claims 46-50, Repke et al teaches like materials which inherently function the same. Also see column 11, lines 25 et seq.

Regarding claim 51, see 9:41 et seq. teaching a outer cover can be two layers. Also, see column 9:11 et seq. teaching the absorbent can be "eveloped" wherein the inner layer of the envelope is consider the liquid-permeable layer (see U.S. 4,756,709, figure 12, showing this configuration or U.S. 4,816,025, etc.).

Claims 44 and 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenji (Japan 4-35498).

Japan teaches a disposable absorbent pant comprising:

a multi-layer chassis including an outer cover 3, a liner 2, and an absorbent structure 4 disposed between said outer cover and said liner, said outer cover having a

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first surface facing said liner and a second surface opposite said first surface, said chassis formed as a pant and including a waist opening and a pair of leg openings, one layer of said multi-layer structure including an extension portion 22 extending beyond an edge of another layer of said multi-layer structure and peripherally surrounding said waist opening; and

a closed-loop waist elastic system including an elongate sleeve member 23 defining an elongate passage therein, said waist elastic system being generally peripherally disposed about said waist opening, and at least one elongate elastic member disposed within said elongate passage, said elongate passage formed by folding said extension portion upon itself and joining an end portion of said extension portion to a surface of said extension portion.

Regarding claims 46-50, like materials inherently function the similarly.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40, 43, 45 and 52 are rejected under 35 U.S.C. § 103 as being unpatentable over Repke et al (4,205,679).



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Repke et al discloses the invention as described above including the extension portion to which the end portion is joined comprises the first surface of the outer cover and not the opposite second surface as claimed. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have folded the extension portion in the opposite direction joining the second surface instead of the first surface. Applicant teaches both configurations and provides no advantage or solves no stated problem; see at least 37:5-8 of 6,336,921 (applicant's specification). One of ordinary skill in the art would have expected applicant's invention to perform equally well with either configuration because both form a passage for the elastic. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Repke et al to obtain the invention as claimed.

Claims 40, 43, 45 and 52 are rejected under 35 U.S.C. § 103 as being unpatentable over Kenji (Japan 4-35498).

Japan discloses the invention as described above including the extension portion to which the end portion is joined comprises the first surface of the outer cover and not the opposite second surface as claimed. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have folded the extension portion in the opposite direction joining the second surface instead of the first surface. Applicant teaches both configurations and provides no advantage or solves no stated problem; see at least 37:5-8 of 6,336,921 (applicant's specification). One of ordinary skill in the art would have expected applicant's invention to perform equally well with either

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configuration because both form a passage for the elastic. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Kenji to obtain the invention as claimed.

In the alternative, claims 46-50 are rejected under 35 U.S.C. § 103 as being unpatentable over Repke et al (4,205,679) in view of Weil et al (5,242,436).

Repke et al discloses the invention as described above. However, Repke et al is silent in regards to the magnitude of decay of the waist elastic system. Weil et al teaches that elastic materials in an elastic waist system undergoing sustained stress/strain (extension/contraction) have diminishing forces with time (i.e. elastic creep). Therefore, it is desired to make sure this reduction in wearing forces over time doesn't fall below a minimum for wearing stability. **The elastic creep (decay) should be kept to a minimum.** See column 34, lines 51 et seq. (Weil et al further teaches the waist elastic system should not have insufficient contractive forces that result in the diaper slipping down after being worn and loaded. In contrast, excessive contractive forces may reduce the comfort for the wearer producing pressure markings on the wearer's skin. See column 34, lines 20 et al.)

It would have been obvious to one having ordinary skill in the art to have utilized the concept of keeping the elastic decay to a minimum and/or materials as taught by Weil et al with the closed-loop waist elastic system of Repke et al to maintain the functional integrity of the waist system over repeated cycling, in doing so, fulfilling the specific claimed decay values/range.

Also, lacking any criticality in the specification, the use of the claimed "decay" values in lieu of those used in the references solves no stated problem and would have been an obvious matter of design choice within the skill of the art.

In the alternative, claims 46-50 are rejected under 35 U.S.C. § 103 as being unpatentable over Kenji (Japan 4-354948) in view of Weil et al (5,242,436).

Kenji discloses the invention as described above. However, Kenji is silent in regards to the magnitude of decay of the waist elastic system. Weil et al teaches that elastic materials in a elastic waist system undergoing sustained stress/strain (extension/contraction) have diminishing forces with time (i.e. elastic creep). Therefore, it is desired to make sure this reduction in wearing forces over time doesn't fall below a minimum for wearing stability. **The elastic creep (decay) should be kept to a minimum.** See column 34, lines 51 et seq. (Weil et al further teaches the waist elastic system should not have insufficient contractive forces that result in the diaper slipping down after being worn and loaded. In contrast, excessive contractive forces may reduce the comfort for the wearer producing pressure markings on the wearer's skin. See column 34, lines 20 et al.)

It would have been obvious to one having ordinary skill in the art to have utilized the concept of keeping the elastic decay to a minimum and/or materials as taught by Weil et al with the closed-loop waist elastic system of Kenji to maintain the functional integrity of the waist system over repeated cycling, in doing so, fulfilling the specific claimed decay values/range.

Also, lacking any criticality in the specification, the use of the claimed "decay" values in lieu of those used in the references solves no stated problem and would have been an obvious matter of design choice within the skill of the art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BRUCE SNOW  
PRIMARY EXAMINER